



US PATENT APPLICATION
Docket No. CRN01-UTL

IN THE UNITED STATES PATENT & TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS & INTERFERENCES

In re application of: LISA A. CORNISH

Serial No. 09/782,371 Examiner: Comstock, David C.
Filed: February 12, 2001 Group Art Unit: 3732
For: HARD HEAD FOIL CAP
Date: November 25, 2003

RECEIVED
DEC 03 2003

TECHNOLOGY CENTER R3700

CERTIFICATE OF MAILING UNDER 37 CFR 1.8
I hereby certify that this correspondence, in triplicate, is being deposited with the United States Postal Service as first class mail, postage pre-paid, in an envelope addressed to: Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on date: November 25, 2003

Wendy M. Fox
WENDY M. FOX

**Mail Stop Appeal Brief-Patents
The Honorable Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**

BRIEF OF THE APPELLANT--CORRECTED

REAL PARTY IN INTEREST

Applicant, Lisa A. Cornish, is the real party in interest to this appeal.

RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences related to the instant appeal.

STATUS OF CLAIMS.

On December 24, 2002, the Examiner rejected Claims 1-17 under 35 U.S.C. 103(a). On April 24, 2003, Applicant filed a Response to the December 24, 2002 office action by directing argument to the Examiner's rejections. Applicant proposed no amendments. On May 14, 2003, the Examiner filed an Advisory Action that the April 24, 2003 response to office action failed to put the application in a condition for allowance.

The Examiner checked the box stating that the proposed amendments would not be entered. However, there were no proposed amendments. On June 24, 2003, Appellant appealed from the final rejections of claims 1-17.

STATUS OF AMENDMENTS.

No amendments have been filed subsequent to the final rejection.

SUMMARY OF INVENTION.

A foiling cap for treating separate portions of the hair to increase ease of foiling or coloring the entire head, and to be able to color or foil designs in and to the hair through designs in the foiling cap. See Specification, page 3, page 5, Ins. 14-25, page 6, Ins. 16-20, and Figs. 1-5. The head cap is provided with a plurality of long narrow slits cut into the head cap in two or more orientations such that shanks of hair can be pulled through any such slit for hair coloring. Id. at page 3, Ins 20-25, and Figs. 1-5. The slits can be placed about the cap in different orientations to create different treatment of, and designs in, the hair of the wearer. Id. The slits all have width in the range of 1/64" to 1/4". Id. at page 6, In. 4. The slits have length in the range of 1" to 4". Id. at page 6, Ins. 3-4. The slits can be zig-zag shaped. Id. at, page 6, Ins. 9-10, and Figs. 4, 5. The slits can be spaced apart with a spacing in the range of 1/2" to 2". Id. at page 6, Ins. 4-5. The slits can be configured with interlocking seams for a linear press-closure, i.e., a ZIP LOCK type partial slit closure, with the seal partially closed to tighten the slit upon the shank of hair. Id. at page 5, Ins. 20-30.

ISSUES.

1. Whether it would have been obvious to modify U.S. Patent No. 3,304,945 to Anderson ("Anderson") to have a slit width range of 1/64" to 1/4".
2. Whether it would have been obvious to modify Anderson to have slits with a zig-zag shape

3. Whether it would have been obvious to modify Anderson to have a slit spacing range of $\frac{1}{2}$ " to 2".

4. Whether Anderson can be combined with U.S. Patent No. 3,103,933 to Sanzo ("Sanzo"), and if so, would such a combination render obvious the ZIP LOCK type partial slit closure of Applicant's invention.

GROUPING OF CLAIMS AND 1.192(C)(7) STATEMENT

Applicant suggests the following six groups of claims, as explained below in the argument: Group I, Claims 1-4, 7, 17; Group II, Claim 5; Group III, Claims 6, 9, 11, and 13; Group IV, Claim 8; Group V, Claims 10, 14, 15; and Group VI, Claims 12 and 16.

Pursuant to 37 CFR 1.192(c)(7), Applicant states a single ground of rejection has been applied to two or more claims in the application, and one or more claims do not stand or fall together. Specifically, Applicant has arranged the Claims into Groups I-VI. The claims from Group I stand or fall together. The Claims from Group II stand or fall together. The Claims from Group III stand or fall together. The Claims from Group IV stand or fall together. The Claims from Group V stand or fall together. The Claims from Group VI stand or fall together. The group of claims is explained in the Argument, Section I below.

ARGUMENT

I. The Claims of the Six Groups Are Separately Patentable

Group I, Claims 1-4, 7, 17, are claims for which the $\frac{1}{64}$ " to $\frac{1}{4}$ " slit width range is the only issue. Group II, Claim 5, is a claim that have both the $\frac{1}{64}$ " to $\frac{1}{4}$ " slit width range and zig-zag slit design issues. Group III, Claims 6, 9, 11, and 13, are claims having both the $\frac{1}{64}$ " to $\frac{1}{4}$ " slit width range and the $\frac{1}{2}$ " to 2" slit spacing range issues. Group IV, Claim 8, is a claim having both the $\frac{1}{64}$ " to $\frac{1}{4}$ " slit width range and the ZIP LOCK type partial slit closure issues. Group V, Claims 10, 14, 15, are claims with the

1/64" to 1/4" slit width range, the 1/2" to 2" slit spacing range, and zig-zag slit design issues. Group VI, Claims 12 and 16, are claims with the 1/64" to 1/4" slit width range, 1/2" to 2" slit spacing range, and the ZIP LOCK type partial slit closure issues.

II. Specific Grounds For Rejection

A. The 1/64" to 1/4" slit width range

The 1/64" to 1/4" slit width range is a feature of every Group. Group I can be decided wholly on this issue alone. The Examiner contended that modifying Anderson to have slits in the range of 1/64" to 1/4" would have been obvious. See Office Action, dated December 24, 2002 at page 5.

Anderson teaches a hair treatment cap for selectively treating locks of hair, provided with a plurality of clamping means. A clamp is made of a fixed element, which is a substantially rigid metal, plastic, or like substance, in conjunction with a movable element which acts like the opening of a jaw for the clamp. Anderson requires that "the lock of hair is firmly clamped in position with a substantially fluid-tight seal whereby there is little or no likelihood that treating solution will seep downwardly through the clamp into contact with hair beneath the opening." See Anderson, col. 3, lines 20-28. According to Anderson, the clamp elements are held in clamping engagement by locking means, with a latch having a cam-shaped sector, which rotates, and which holds hair in a fluid type manner "preventing seepage of the treating agent under the cap". See Anderson, col. 3, lines 29-41. Suitable clamps include a bifurcate spring clip with two jaw elements. Id.

The slit width of 1/64" to 1/4" limitation is not present in Anderson nor rendered obvious by Anderson because Applicant's invention does not have a clamp, as taught in Anderson. In Applicant's invention, the width remains unchanged in use as the slit is not closed (except in the case of the ZIP LOCK type partial slit closure, in which case the slits are partially closed). Anderson requires that the slits be clamped shut. When

clamped shut they will not have width of 1/64" to 1/4", as taught by Applicant. The requirement in Anderson of firmly shutting clamps precludes the slit width of Applicants' invention. Anderson specifically precludes having such a wide gap, stating "the lock of hair is firmly clamped in position with a substantially fluid-tight seal". See Anderson, col. 3, lines 23-27. Anderson specifically includes in its definition of "slit" the jaw like elements of the clamps. See Anderson, col. 4, lines 34-35.

The Examiner stated that finding an optimum range is within the level of those skilled in the art. However, optimum range for Anderson's firmly sealed jawlike clamps will not be the optimum range for Applicant's slits. Anderson specifically teaches a zero, or as close to zero, width range when closed as possible. Applicant specifically teaches a range of 1/64" to 1/4" width at all times, with the only exception being for the ZIP LOCK closure, in which case the slits are only "partially" closed. If anything, the firmly sealed jawlike clamps of Anderson teach away from the width range of Applicant's invention.

B. The ZIP LOCK type partial slit closure

The ZIP LOCK type partial slit closure is a feature of Groups IV and VI. The Examiner contended that "Sanzo discloses a similar device" and that it would have been obvious to modify Anderson to have the closure of Sanzo. See Office Action at page 4-5. The Examiner stated that "Sanzo is similar to both Applicant's invention and to Anderson". See Office Action at page 6. Thus, the Examiner contends that Sanzo has a ZIP LOCK type partial slit closure, which Anderson can be modified to include, and therefore that modified combination would render obvious Applicant's invention.

First, Sanzo does not teach a ZIP LOCK type partial slit closure. To the contrary, Sanzo describes its closure element as follows:

"Along each of these edges, there is provided a groove within which is received a strip or rib of sponge rubber which strips come together when the container is closed to seal it and to grip and hold the hair which is held within the container....

...
“These edges are similarly provided each with a groove and a strip or rib of sponge rubber, for example, in the grooves which strips come together to seal and grasp and hold the lock or strands of hair when the container is closed.”

See Sanzo, col. 2, Ins 28-32 & col. 3, Ins. 32-37. Applicant, on the other hand, describes its ZIP LOCK type closure, which is only partially closed at any time, as follows:

“Alternatively, the slits can be configured in a zip lock fashion such that the slit can be **partially closed** to tighten the slit upon the shank of the hair creating the **additional firmness needed to keep hair secure** when pulled through the sits. Zip lock refers to **interlocking seams** for a linear press-closure which **holds together by interference** between two linear elements of either side of the seal, with or without a movable closure element, such as those sold under the trademark ZIPLOC.”

Specification, page 5, Ins 22-28 (emphasis added). Here, Applicant’s invention requires a press closure of “interlocking seams” held together by “interference” between two linear elements “of either side of the seal”. Applicant’s invention makes no mention of a rubber or sponge gripper. Sanzo does not teach “interlocking seams” and “interference”.

Further, Applicant’s invention has the slit only “partially closed”, whereas in both Sanzo and Anderson, the clamping apparatus are shut tight. See Sanzo, col. 2, Ins 28-32 & col. 3, Ins. 32-37; Anderson, col. 3, Ins. 20-41.

Further, Anderson and Sanzo cannot be combined. First, Anderson teaches a head cap that goes over a head, with a plurality of slits made of jaw elements which clamp tightly shut on hair locks, whereas Sanzo, on the other hand, teaches a hair enclosure that does not fit over the head, but rather, individual locks of hair are trapped in an enclosed container and treated. See Anderson, col. 3, Ins. 20-41, col. 4, Ins. 30-35 & Fig. 1; Sanzo, col. 2, Ins 17 to col. 3, In. 37 & Fig 1. The hair locks in Sanzo are sealed within the container. See Sanzo, id. Second, there is no motivation to combine Anderson and Sanzo, and there is no reasonable likelihood that if such a combination were attempted that it would actually work. Anderson specifically requires that hair locks

be clamped, with the ends of the hair extending freely beyond the clamp. See Anderson, col. 3, Ins. 20-41. Anderson thus forecloses the use of Sanzo, which requires hair to be sealed within a container, not extending freely.

Moreover, the modifications to Anderson by Sanzo that the Examiner asserts are required to come from the references themselves, as is the reasonable degree of success of such a combination. See MPEP 2143. "It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art." Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 230 USPQ 416 (Fed. Cir. 1986). Here, Sanzo teaches a hair enclosing contraption, which traps individual locks of hair for treatment—the antitheses of a cap where individual locks of hair are pulled through and are free. See Sanzo, col. 2, Ins 17 to col. 3, In. 37 & Fig 1. Sanzo would not lead a practitioner either to practice Anderson or Applicant's invention.

There was no reference in Sanzo or Anderson that could be construed as a motivation to modify Anderson by an element in Sanzo. In fact, there is nothing in Sanzo or Anderson to suggest how Anderson could, in fact, be mechanically modified by Sanzo. There was no showing of what level of success should be expected by someone who would attempt to modify Anderson to have the features of Sanzo.

Accordingly, the rejections were in error.

C. The zig-zag shaped slits

The zig-zag shaped slits is a feature of Groups II and V. The Examiner contended that modifying Anderson to have the zig-zag shape would have been an obvious matter of design choice, on the assertion that "applicant has not disclosed that the zig-zag shape solves any stated problem or is for any particular purpose." See Office

Action at page 4. The Examiner further stated that "the zig-zag shapes does not appear to be anything more than one of numerous shapes or configurations a person ordinary skill in the art would find obvious." See Office Action at page 4. Here, Applicants invention, with respect to the zig-zag, serves the purpose of imparting a zig-zag design to the hair of the person whose hair is being colored. See Specification p. 2, lns 19-22, p 3, lns 8-11 & 23-25, pg 4, lns 14-20, pg 6, lns 9-15. Thus, it has a functional purpose not addressed by either Anderson or Sanzo, nor mentioned or even suggested by Anderson or Sanzo. Moreover, Anderson is contrary to a zig-zag shape because the straight clamps disclosed and explicitly taught in Anderson preclude a zig-zag shape. Accordingly, the rejections were in error.

D. The ½" to 2" slit spacing range

The ½" to 2" slit spacing range is a feature of Groups III, V, and VII. The Examiner contended that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to space the slits apart with a spacing in the range of ½" to 2" on the contention that "it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art." See Office Action at page 3. However, optimum range between Anderson's jawlike clamps will not be the optimum range between Applicant's slits. It is submitted that an optimum range for Anderson will not correspond to an optimum range for Applicant's invention, and thus, Applicant's range is not rendered obvious by Anderson. Accordingly, the rejections were in error.

SUMMARY

For the foregoing reasons, Appellant believes that the Examiner's rejections of Claims 1-17 were erroneous, and reversal of the decisions is respectfully requested.

Respectfully submitted,

KURT M. RYLANDER
TRIAL & PATENT ATTORNEY AT LAW PC

KURT M. RYLANDER
USPTO Reg. No. 43,897

1014 Franklin Street, Suite 206
Vancouver, Washington 98660
(360) 750-9931

APPENDIX

1. A hard head foil cap, comprising:
 - a. a head cap; and
 - b. a plurality of long narrow slits cut into the head cap such that shanks of hair can be pulled through any such slit for hair coloring, and wherein the slits have width in the range of 1/64" to 1/4".
2. The hard head foil cap of claim 1, wherein said cap is made of plastic, foam, or rubber, or waterproof fabric.
3. The hard head foil cap of claims 1 or 2, wherein the slits are configured in two or more orientations.
4. The hard head foil cap of claim 1 or 2, wherein the slits have length in the range of 1" to 4".
5. The hard head foil cap of claims 1 or 2, wherein said slits are zig-zag shaped.
6. The hard head foil cap of claims 1 or 2, wherein the slits are spaced apart with spacing in the range of 1/2" to 2".
7. The hard head foil cap of claims 1 or 2, wherein the slits are reinforced by one of the group selected from stitching the slits and adding thicker plastic around the slits.
8. The hard head foil cap of claims 1 or 2, wherein the slits are configured with interlocking seams for a linear press-closure which holds together by interference between two linear elements of either side of the seal such that the slit can be partially closed to tighten the slit upon the shank of the hair.
9. A hard head foil cap, comprising:
 - a. a head cap, wherein said cap is made of plastic, foam, or rubber, or waterproof fabric; and
 - b. a plurality of long narrow slits cut into the head cap such that shanks of hair can be pulled through any such slit, and wherein the slits are configured in two or more orientations, wherein the slits have length in the

range of 1" to 4" and width in the range of 1/64" to $\frac{1}{4}$ ", and wherein the slits are spaced apart with spacing in the range of $\frac{1}{2}$ " to 2".

10. The hard head foil cap of claim 9, wherein said slits are zig-zag shaped.
11. The hard head foil cap of claims 9 or 10, wherein the slits are reinforced by one of the group selected from stitching the slits and adding thicker plastic around the slits.
12. The hard head foil cap of claim 9, wherein the slits are configured with interlocking seams for a linear press-closure which holds together by interference between two linear elements of either side of the seal such that the slit can be partially closed to tighten the slit upon the shank of the hair.
13. A method of treating hair, comprising steps of:
 - a. Placing a head cap over the hair of the person whose hair is to be colored, wherein said cap is made of plastic, foam, or rubber, or waterproof fabric, wherein said cap is provided with a plurality of long narrow slits cut into the head cap such that shanks of hair can be pulled through any such slit for hair coloring, and wherein the slits are configured in two or more orientations, wherein the slits have length in the range of 1" to 4" and width in the range of 1/64" to $\frac{1}{4}$ ", and wherein the slits are spaced apart with spacing in the range of $\frac{1}{2}$ " to 2";
 - b. Pulling shanks of hair through said slits;
 - c. Treating said hair shank by coloring, frosting, foiling, bleaching or dying; and
 - d. Repeating steps (b) through (c) until the hair is the treatment is done.
14. The method of coloring hair of claim 13, wherein said slits are zig-zag shaped.
15. The method of coloring hair of claims 13 or 14, wherein the slits are reinforced by one of the group selected from stitching the slits and adding thicker plastic around the slits.
16. The method of coloring hair of claim 13, wherein the slits are configured with interlocking seams for a linear press-closure which holds together by interference

between two linear elements of either side of the seal such that the slit can be partially closed to tighten the slit upon the shank of the hair.

17. A head cap made from the process consisting of:
 - a. Cutting a plurality long narrow slits along the sides of a hair cap, wherein said slits with length between 1" and 4" and width between 1/64" and 1/4"; and
 - b. Cutting a plurality of long narrow slits around the top of a hair cap, wherein said slits have length between 1" and 4" and width between 1/64" and 1/4".